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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/541,895

02/16/2006

Robert L Garcea

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PATENT DOCKETING
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EXAMINER

SALIMI, ALI REZA

ART UNIT

PAPER NUMBER

1648

MAIL DATE

DELIVERY MODE

06/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/541,895	Applicant(s) GARCEA ET AL.	
	Examiner A R. Salimi	Art Unit 1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,7-18,22-25,27,31-33,35,37 and 43-54 is/are pending in the application.
- 4a) Of the above claim(s) 1,5,7-18,22-25,27,31-33,35 and 46-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37,43-45 and 49-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/16/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group IV (claims 37, 43-45, and 49-54) in the reply filed on 4/18/2008 is acknowledged.

Claims 1, 5, 7-18, 22-25, 27, 31-33, 35, 46-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups. Election was made **without** traverse in the reply filed on 04/18/2008.

Applicants are reminded to cancel the claims to the non elected Group(s).

Claim Objections

Claims 44-45 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim 42 has been canceled. See MPEP § 608.01(n). Accordingly, the claims 44-45 have been further treated as though they are dependent from claim 37, however, this does not relieve the Applicants from appropriate correction and/or modification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 37, 43-45 and 49-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Gissmann et al (US Patent no. 7,371,391 B2).

The above cited patent clearly anticipates the broad limitations of the claimed invention. Gissmann et al taught chimeric protein comprising papillomavirus L1 protein and another protein wherein the composition forms capsomere (see the abstract, and claims 1-14).

Claims 37, 43, 50, 52-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilson et al (US Patent no. 6,908,613 B2).

The above cited patent clearly anticipates the broad limitations of the claimed invention. Wilson et al taught chimeric protein comprising papillomavirus L1 protein and another protein (see the abstract, and claims 1, 3-5).

Claims 37, 43-45 and 49-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Hallek et al (US Patent no. 7,182,947 B2).

The above cited patent clearly anticipates the broad limitations of the claimed invention. Hallek et al taught chimeric protein comprising papillomavirus L1 protein and another protein wherein the composition forms capsomere (see the abstract, and claims 1-15).

Claims 37, 43, 50, 52-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Mizzen et al (US Patent no. 6,524,825 B1).

The above cited patent clearly anticipates the broad limitations of the claimed invention. Mizzen et al taught fusion protein comprising papillomavirus L1 protein and another protein (see the abstract, and claims 1-15).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37, 43-45 and 49-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Gissmann et al (US Patent no. 6,228,368 B1).

The above cited patent clearly anticipates the broad limitations of the claimed invention. Gissmann et al taught chimeric protein comprising papillomavirus L1 protein and another protein wherein the composition forms capsomere (see the abstract, and claims 1-14).

Claims 37, 43-45 and 49-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Garcea et al (US Patent no. 6,165,471 A).

The above cited patent clearly anticipates the broad limitations of the claimed invention. Garcea et al taught chimeric protein comprising papillomavirus L1 protein and another protein wherein the composition forms capsomere (see the abstract, all the claims, specifically claims 1-19). Additionally, under inherency doctrine where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or

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substantially identical processes, a prima facie case of anticipation has been established. See, In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

No claims are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. R. Salimi whose telephone number is (571) 272-0909. The examiner can normally be reached on Monday-Friday from 9:00 Am to 6:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The Official fax number is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/A R Salimi/

Primary Examiner, Art Unit 1648

06/04/2008